

REMARKS

Claims 1-77 are currently pending. Claim 71 has been amended to better clarify what Applicants believe to be the invention. New claim numbers 78-82 have been added for consideration. Applicants assert that the subject matter of new claims 78-82 fall within the classification of the claims elected by way of this restriction requirement. Support for new claims 78-82 can be found in original claim 66 and throughout the specification. No issue of new matter is believed to be introduced by this amendment. If the aforementioned claim amendments are entered, the claims under consideration will be claims 1-82.

In the Requirement for Restriction, the Examiner requested election of one of the following groups:

- Group I. Claims 1-25 and 73-75, drawn to method for identifying an agent capable of modulating the interaction between a transcription factor and a Stat protein.
- Group II. Claims 26-47 and 73-75, drawn to method for identifying an agent capable of modulating the transcriptional cooperation between a transcription factor and a Stat protein.
- Group III. Claims 48-64, drawn to method for identifying a mutant in a molecule, classified in class 435.
- Group IV. Claims 65-67 and 71, drawn to Stat protein fragment or mutant.
- Group V. Claims 68-70 and 72 drawn to polynucleotide encoding a Stat protein or fragment.
- Group VI. Claims 76-77 drawn to method for identifying a mutant Stat protein.

Furthermore, the Examiner has also noted that an election of species is required for both the Stat proteins and the transcription factors. In particular, the Examiner has noted that the application contains claims directed to the following patentably distinct species types of the claimed invention:

- Group I.
 - 1. Claims particular transcription factor or fragment;
 - 2. Claims particular Stat protein or fragment.
- Group II.
 - 1. Claims particular transcription factor or mutant;
 - 2. Claims particular Stat protein or mutant.

- Group III. 1. Claims particular transcription factor;
 2. Claims particular Stat protein.

- Group IV and V. 1. Claims particular Stat protein fragment or mutant.

Applicants hereby elect Group IV, claims 65-67 and 71, drawn to Stat protein fragment or mutant with traverse. Furthermore, with respect to the species election, Applicants elect residues 107-377 of Stat3 fragment as depicted in SEQ ID NO: 9, without traverse. The claims that currently read on the species elected are claims 65, 66, 67, 71 and new claims 78-82.

Applicants respectfully request reconsideration of the Requirement for Restriction, or in the alternative, modification of the Restriction Requirement to allow prosecution of more than one group of claims designated by the Examiner in the present Application, for the reasons provided as follows.

Under 35 U.S.C. §121 "two or more independent and distinct inventions ... in one Application may ... be restricted to one of the inventions." Inventions are "'independent'" if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP 802.01). The term "'distinct'" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER" (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, "[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

Applicants respectfully submit that the groups designated by the Examiner fail to define compositions and methods, with properties so distinct as to warrant separate Examination and Search. Claims 65-67 and 71, of elected Group IV are drawn to a Stat protein fragment. Applicants assert that a search for subject matter pertaining to the

claims that fall within this elected group IV (claims 65-67, 71 and new claims 78-82) would result in identification of subject matter related to methods of identifying modulators of said proteins and mutants of said proteins, the subject matter of which falls within the scope of the claims of Group II (claims 26-47 and 73-75), Group III (claims 48-64), as well as the claims of Group VI, 76-77, and as such, Applicants assert that all of these claims are fundamentally related. Applicants respectfully assert that the search for the stat protein fragments separately classified by the Examiner as the invention of Group IV would require an additional search of related subject matter of Groups II, III and VI, thus resulting in a duplicate search for related material. Thus, Applicants submit that the Search and Examination of the entire Application, or, at least, of Groups II, III and VI with elected Group IV can be made without serious burden, and therefore the Examiner must examine all of the claims, or in the alternative, at least those of Groups II, III and VI with elected Group IV, of the Application on the merits.


The Examiner's assertions to the contrary notwithstanding, Applicants respectfully submit that conjoint examination and inclusion of all of the Claims of the present Application would not present an undue burden on the Examiner, and accordingly, withdrawal of the Requirement for Restriction, or, at the least, modification to include the claims drawn to Groups II, III and VI with elected Group IV is in order.

In view of the above, withdrawal of the Requirement for Restriction is requested, and an early action on the merits of the claims is courteously solicited.

Fees

No fees are believed to be necessitated by the instant response. However, should this be in error, authorization is hereby given to charge Deposit Account No. 11-1153 for any underpayment, or to credit any overpayments.

Respectfully submitted,



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